

REMARKS/ARGUMENTS

Applicant respectfully submits that the obviousness rejections are improper and should be withdrawn. A mere conjecture that one would combine the cited references because the disclosure of one reference "would improve" the disclosure of another cited reference art does not constitute a proper motivation to combine as required by 35 U.S.C. § 103. Additionally, it is respectfully submitted that the proposed combinations of references (Sabelhaus and Menzies; and Sabelhaus, Menzies and Ismael) do not yield the subject matter that the Examiner suggests. In light of this, the Examiner's rejections are unsupported by the art and should be withdrawn. These points are discussed in detail below.

Proposed Combinations do not Yield Subject Matter of the Claims

Claims 1, 2, 4, 5, 7-10 and 12-15 are rejected as being unpatentable over Sabelhaus in view of Menzies. Claims 3, 6, 11, 16 and 17 are rejected as being unpatentable over Sabelhaus in view of Menzies as applied to claim 1, and further in view of Ismael. Applicant first respectfully submits that the Examiner has mischaracterized the references – at least the Sabelhaus reference, in particular. As a result, the Examiner has not made a proper showing that the combinations of references, in fact, yield the subject matter suggested by the Examiner.

In the first place, the Examiner asserts, in part, that Sabelhaus discloses identifying a selected repository and its associated communication protocol. The Examiner further asserts that Sabelhaus discloses a repository API that creates a protocol-specific object and returns this protocol-specific object to an object manager. Applicants respectfully disagree with this interpretation.

As discussed in detail below, the Examiner asserts that Sabelhaus discloses "at least one repository" that "has an associated communication protocol." On the other hand, the Sabelhaus repository (MIB 32) is, in fact, protocol independent. For example, see col. 3, lines 33-35 of Sabelhaus, which discloses: "Accordingly, all protocol-specific processing is local to the subsystems 30, allowing the MIB 32 to be protocol independent."

To the extent the Examiner may be contending that the "associated communication protocol" is the common management protocol by which transactions are processed by the MIB 32, then this is inconsistent with the Examiner's further assertion that Sabelhaus discloses passing a communication protocol indicator identifying the "associated communication protocol" to the repository API 60. At best, each Sabelhaus subsystem 30 passes to the API 60 of the MIB

32 a protocol indicator identifying a communication protocol in which the particular subsystem 30 operates, and not identifying a communication protocol in which the MIB 32 operates. The messages passed by the subsystems 30 to the API 60 have no indication whatsoever of the "common management protocol" of the MIB 32.

Menzies is only relied upon by the Examiner for its alleged disclosure of a Common Information Model repository and not for an alleged disclosure of "each repository has an associated communication protocol" and the other features discussed above. Thus, the Examiner's allegations with respect to Menzies do not cure the deficiencies in the allegations with respect to Sabelhaus.

Ismael is only relied upon for its alleged disclosure of an "associated communication protocol" being LDAP, JDBC or JAVA. However, the Examiner does not allege that Ismael discloses at least one "repository," let alone at least one repository that "has an associated communication protocol." Nor does the Examiner rely on Ismael for any of the other features discussed above. Thus, the Examiner's allegations with respect to Ismael do not cure the deficiencies in the allegations with respect to Sabelhaus.

The Examiner makes further allegations that Sabelhaus discloses the feature of a "factory class" arranged to produce a protocol-specific object. Applicant's claims including this feature have been cancelled. As a result, this portion of the Examiner's allegations are not being addressed here.

It can thus be seen that the Examiner's allegations are insufficient to set forth a proper prima facie case that the combination of cited references yield the subject matter recited in the rejected claims.

Motivation for Combination is not Sufficient for a Prima Facie Case of Obviousness

It is respectfully further submitted that the Examiner has not stated a proper motivation for combining the various cited references. The motivation stated by the Examiner for combining Menzies and Sabelhaus is that "the teachings of Menzies would improve the system of Sabelhaus by providing means for translating and storing MIB objects." The motivation stated by the Examiner for combining Menzies, Sabelhaus and Ismael is that "the teaching of Ismael would improve the system of Sabelhaus by a means of interaction between applications and agent." These stated motivations spring from impermissible hindsight reasoning, and are not sufficient to support a prima facie case of obviousness.

It is well settled that, for a proper prima facie case of obviousness, the prior art itself must suggest the desirability of the claimed subject matter. The Examiner is referred, for example, to MPEP 2143.01. There, it is discussed that the source of the motivation must be the cited references themselves or knowledge held by one of ordinary skill in the art. Furthermore, the Examiner is reminded that "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in applicant's disclosure." See MPEP 2143.

Here, the Examiner has pointed to nothing in the references or knowledge held by one of ordinary skill in the art that would suggest the alleged combinations of references. A bald, unsupported assertion that the teachings of a secondary reference "would improve" the teachings of a primary reference are insufficient. The Examiner has not pointed to anything in the references or knowledge held by one of ordinary skill in the art regarding the alleged improvement. Therefore, the Examiner must be relying on the impermissible hindsight gleaned from Applicant's disclosure, and the obviousness rejection is insufficient for this reason, too.

The Examiner has not provided a proper motivation to combine the references. Therefore, the rejection is unsupported by the cited references and should be withdrawn.

CONCLUSION

For at least the reasons set forth above, Applicant thus respectfully requests that the rejections of the claims be withdrawn, and Applicant respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at (650) 314-5324.

Respectfully submitted,

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